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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,349	09/18/2000	Mark A. Harper	10003223-1	4554

			EXAMINER
22879	7590	05/24/2004	THEIN, MARIA TERESA T

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FORT COLLINS, CO 80527-2400

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.		Applicant(s)	
Office Action Summary		09/665,349		HARPER ET AL.	
		Examiner		Art Unit	
		Marissa Thein		3625	$M\mathcal{U}$

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _25 February 2004_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-28_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-28_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicants' "Remarks" filed on February 23, 2004 has been considered.

Claims 24-28 are added. Claims 1-28 remain pending in this application.

Terminal Disclaimer

The terminal disclaimer filed on February 23, 2004 disclaiming the terminal

portion of any patent granted on this application which would extend beyond the

expiration date of Application No. 09/648,664 has been reviewed and is accepted. The

terminal disclaimer has been recorded.

Response to Arguments

Applicant's arguments with respect to claims 1-26 have been considered but are

moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. The phrase "If an amount of a consumable....is less than a

predetermined threshold" is in a conditional sense. A method is composed of an "act" or

series of "acts" thus performed. The noted conditional acts are not necessarily

performed. Accordingly, and as in the method itself, once the positively recited "acts"

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regards as the invention. The phrase "If an amount of a consumable....is less than a

predetermined threshold" is in a conditional sense. A method is composed of an "act" or

series of "acts" thus performed. The noted conditional acts are not necessarily

performed. Accordingly, and as in the method itself, once the positively recited "acts"

are satisfied, the method as a whole is satisfied -- regardless of whether or not other

"acts" are conditionally invocable under certain other hypothetical sceanerios.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 4, 6-8, 11-12, 14-15, 17, 19, and 21-28 rejected under 35 U.S.C.

103(a) as being unpatentable over U.S. Patent No. 6,108,099 to Ohtani in view of

U.S. Patent No. 6,430,711 to Sekizawa. Regarding claim 1, Ohtani discloses a

method of programming a memory unit and obtaining consumable supplies in a hard

copy output engine comprising:

- determining an electronic address for a consumables supplier appropriate to the

  geographical area (see at least Figures 4-6; col. 2, lines 1-12; col. 5, lines 14-25;

  col. 6, lines 10-20);

- programming the electronic address into the memory (see at least col. 5, lines

  33-48; col. 8, lines 28-32; col. 9, lines 29-33);

However, Ohtani does not explicitly disclose the non-volatile memory. Ohtani

discloses the system controller stores the inputted E-mail address in the parameter

memory (col. 5, lines 23-25). The non-volatile memory, as defined in Random House

Computer & Internet Dictionary (1999), is the types of memory that retained their

contents when power is turned off. To one of ordinarily skilled in the art, one wants to

maintain an address or information in a memory when the power is shut off. In addition,

one tends to want a memory that does not lose its data when the power is turned off.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention was made to modify the method of Ohtani, to include the non-volatile memory

for the purpose of maintaining or retaining the address.

Furthermore, Ohtani does not disclose the geographical area within which the

hard copy output engine is to be deployed. Ohtani discloses an image forming

apparatus used in facsimile machines, copy machines, printers that are connected to a

communication network like a LAN and have a function for sending an electronic mail to

a destination terminal (col. 2, lines 57-62). Furthermore, Ohtani discloses the network

terminals including the facsimile machine 20 and personal computer 30 send E-mail to

another terminal connected to the LAN 50 or a destination client terminal connected to a

wide-area network like the Internet, the sent E-mail is first stored in the server 40 and is

then sent to an addressed terminal (col. 3, lines 19-25). Sekizawa, on the other hand,

teaches the geographical area within which the hard copy output engine is to be

deployed (see at least col. 4, lines 1-5; col. 8, lines 3-19; col. 23, lines 39-45; col. 25,

lines 55-64; col. 27, lines 8-14; col. 36, lines 51-58).

It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to modify the method of Ohtani, to include the geographical area,

as taught by Sekizawa, so an operator can easily determine the area in which the

machine requires a supply or maintenance and can efficiently deliver the supply

(Sekizawa col. 8, lines 13-16).

Regarding claims 4, 6-7, 14 and 19, Ohtani discloses product descriptors for

consumable supplies associated with the hard copy output engine (see at least col. 2,

lines 57-62; col. 3, lines 19-25); the hard copy output engine is chosen from the group

consisting of: facsimile machines, photocopiers and printers (see at least col. 2, lines

58-59); and a supplier chosen from the group consisting of: an original equipment

manufacturer, a reseller, or a supplier of office supplies including hard copy output

engine consumables (see at least Figure 4; col. 5, lines 33-48).

Regarding claim 8, Ohtani discloses a method of obtaining consumable supplies

for a hard copy:

- the extracting of an electronic address for a vendor from a memory (see at least

  Figures 4-6; col. 2, lines 1-12; col. 5, lines 14-25; col. 6, lines 10-20);

- initiating communication with the vendor using the electronic address (see at

  least col. 5, lines 19-25; col. 6, lines 34-36; col. 7, lines 24-30).

However, Ohtani does not explicitly disclose the non-volatile memory. Ohtani

discloses the system controller stores the inputted E-mail address in the parameter

memory (col. 5, lines 23-25). The non-volatile memory, as defined in Random House

Computer & Internet Dictionary (1999), is the types of memory that retained their

contents when power is turned off. To one of ordinarily skilled in the art, one wants to

maintain an address or information in a memory when the power is shut off. In addition,

one tends to want a memory that does not lose its data when the power is turned off.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Ohtani, to include the non-volatile memory for the purpose of maintaining or retaining the address.

Furthermore, Ohtani does not disclose determining that an amount of consumable for the hard copy output engine is less than a threshold amount. Ohtani determines when the toner and paper is out (see at least col. 6, lines 10-24). Sekizawa, on the other hand, teaches the determining that an amount of consumable for the hard copy output engine is less than a threshold amount (see at least col. 9, lines 44-57; col. 10, lines 3-8; col. 15, lines 22-32; col. 28, lines 44-67; col. 34, lines 23-54). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Ohtani, to include determining that an amount of consumable for the hard copy output engine is less than a threshold amount, as taught by Sekizawa, so an operator can easily keep track of the consumable consumption tendency for each machines based on the predicted statistics (Sekizawa col. 9, lines 18-21). Thus, the consumable article can be prevented from running out (Sekizawa col. 9, lines 29-30).

Regarding claims 11-12, and 17, Sekizawa discloses a predetermined quantity of the consumable determined to be present in an amount less than the threshold amount (see at least col. 19, lines 15-35; col. 46, lines 7-31); and the determining comprises determining using processing circuitry in response to a sensor in the hard copy output engine sensing that an amount of the consumable is less than the threshold amount (see at least col. 19, lines 22-27; col. 33, lines 31-35; col. 34; col. 34, lines 22-55).

Regarding claim 15, Ohtani discloses a computer implemented control system for

a hard copy output engine, the system comprising:

- memory included in the hard copy output engine configured to store data

  representing an electronic address for a supplier of consumables see at least

  Figures 4-6; col. 2, lines 1-12; col. 5, lines 14-25; col. 6, lines 10-20; col. 5, lines

  33-48; col. 8, lines 28-32; col. 9, lines 29-33); and

- processing circuitry configured (see at least col. 4, lines 45-52; col. 3, lines 49-

  56) to:

  - extract the electronic address from the memory (see at least Figures 4-6;

    col. 2, lines 1-12; col. 5, lines 14-25; col. 6, lines 10-20); and

  - initiate communication with the supplier using the electronic address (see

    at least col. 5, lines 19-25; col. 6, lines 34-36; col. 7, lines 24-30).

However, Ohtani does not explicitly disclose the non-volatile memory. Ohtani

discloses the system controller stores the inputted E-mail address in the parameter

memory (col. 5, lines 23-25). The non-volatile memory, as defined in Random House

Computer & Internet Dictionary (1999), is the types of memory that retained their

contents when power is turned off. To one of ordinarily skilled in the art, one wants to

maintain an address or information in a memory when the power is shut off. In addition,

one tends to want a memory that does not lose its data when the power is turned off.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention was made to modify the method of Ohtani, to include the non-volatile memory

for the purpose of maintaining or retaining the address.

Furthermore, Ohtani does not disclose determining that an amount of consumable for the hard copy output engine is less than a threshold amount. Ohtani determines when the toner and paper is out (see at least col. 6, lines 10-24). Sekizawa, on the other hand, teaches the determining that an amount of consumable for the hard copy output engine is less than a threshold amount (see at least col. 9, lines 44-57; col. 10, lines 3-8; col. 15, lines 22-32; col. 28, lines 44-67; col. 34, lines 23-54). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Ohtani, to include determining that an amount of consumable for the hard copy output engine is less than a threshold amount, as taught by Sekizawa, so an operator can easily keep track of the consumable consumption tendency for each machines based on the predicted statistics (Sekizawa col. 9, lines 18-21). Thus, the consumable article can be prevented from running out (Sekizawa col. 9, lines 29-30).

Regarding claims 21-22, Ohtani the initiating comprises directly initiating communication with the vendor from the hard copy output engine (see at least col. 5, lines 19-25; col. 6, lines 34-36; col. 7, lines 24-30) and the process circuitry (see at least col. 4, lines 45-52; col. 3, lines 49-56).

Regarding claim 23, a method of obtaining consumable supplies for a hard copy output engine comprising:

- determining an electronic address for a consumables supplier appropriate to the geographical area (see at least Figures 4-6; col. 2, lines 1-12; col. 5, lines 14-25; col. 6, lines 10-20);

- programming the electronic address into the memory (see at least col. 5, lines 33-48; col. 8, lines 28-32; col. 9, lines 29-33); and

- proactively initiating communication with the consumables supplier from the hard copy output engine and using he stored electronic address (see at least col. 5, lines 19-25; col. 6, lines 34-36; col. 7, lines 24-30).

However, Ohtani does not explicitly disclose the non-volatile memory. Ohtani discloses the system controller stores the inputted E-mail address in the parameter memory (col. 5, lines 23-25). The non-volatile memory, as defined in Random House Computer & Internet Dictionary (1999), is the types of memory that retained their contents when power is turned off. To one of ordinarily skilled in the art, one wants to maintain an address or information in a memory when the power is shut off. In addition, one tends to want a memory that does not lose its data when the power is turned off. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Ohtani, to include the non-volatile memory for the purpose of maintaining or retaining the address.

Furthermore, Ohtani does not disclose the geographical area within which the hard copy output engine is to be deployed. Ohtani discloses an image forming apparatus used in facsimile machines, copy machines, printers that are connected to a communication network like a LAN and have a function for sending an electronic mail to a destination terminal (col. 2, lines 57-62). Furthermore, Ohtani discloses the network terminals including the facsimile machine 20 and personal computer 30 send E-mail to another terminal connected to the LAN 50 or a destination client terminal connected to a

wide-area network like the Internet, the sent E-mail is first stored in the server 40 and is then sent to an addressed terminal (col. 3, lines 19-25). Sekizawa, on the other hand, teaches the geographical area within which the hard copy output engine is to be deployed (see at least col. 4, lines 1-5; col. 8, lines 3-19; col. 23, lines 39-45; col. 25, lines 55-64; col. 27, lines 8-14; col. 36, lines 51-58).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Ohtani, to include the geographical area, as taught by Sekizawa, so an operator can easily determine the area in which the machine requires a supply or maintenance and can efficiently deliver the supply (Sekizawa col. 8, lines 13-16).

Moreover, Ohtani does not disclose determining that an amount of consumable for the hard copy output engine is less than a threshold amount. Ohtani determines when the toner and paper is out (see at least col. 6, lines 10-24). Sekizawa, on the other hand, teaches the determining that an amount of consumable for the hard copy output engine is less than a threshold amount (see at least col. 9, lines 44-57; col. 10, lines 3-8; col. 15, lines 22-32; col. 28, lines 44-67; col. 34, lines 23-54). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Ohtani, to include determining that an amount of consumable for the hard copy output engine is less than a threshold amount, as taught by Sekizawa, so an operator can easily keep track of the consumable consumption tendency for each machines based on the predicted statistics (Sekizawa col. 9, lines 18-21). Thus, the consumable article can be prevented from running out (Sekizawa col. 9, lines 29-30).

Regarding claims 24, 27-28, Ohtani discloses substantially the claimed invention, however, it does not disclose the determining and the programming are performed prior to deployment of the hard copy output engine in an user environment. The particular way to determine and program does not patentably distinguish the claimed system because it imparts no structural or functional specificity. Furthermore, applicant has not persuasively demonstrated that the particular way to determine and program is critical or is anything more than one of the numerous ways that the skilled artisan would have found suitable for the purpose taught by Ohtani. Therefore, it would have been obvious to one or ordinary skill in the art at the time of the invention to provide any way to determine and program in the method taught by Ohtani because the subjective interpretation of the particular way to determine and program does not patentably distinguish the claimed invention.

Regarding claim 25, Ohtani disclose the programming into the memory resident within the hard copy output engine (see at least col. 3, lines 63-66; col. 5, lines 14-17).

Regarding claim 26, Ohtani disclose substantially the claimed invention, specifically, the determining of the electronic address corresponding to the hard copy output engine (see at least Figures 4-6; col. 2, lines 1-12; col. 5, lines 14-25; col. 6, lines 10-20). However, Ohtani does not disclose the geographical area within which the hard copy output engine is to be deployed. Ohtani discloses an image forming apparatus used in facsimile machines, copy machines, printers that are connected to a communication network like a LAN and have a function for sending an electronic mail to a destination terminal (col. 2, lines 57-62). Furthermore, Ohtani discloses the network

terminals including the facsimile machine 20 and personal computer 30 send E-mail to another terminal connected to the LAN 50 or a destination client terminal connected to a wide-area network like the Internet, the sent E-mail is first stored in the server 40 and is then sent to an addressed terminal (col. 3, lines 19-25). Sekizawa, on the other hand, teaches the geographical area within which the hard copy output engine is to be deployed (see at least col. 4, lines 1-5; col. 8, lines 3-19; col. 23, lines 39-45; col. 25, lines 55-64; col. 27, lines 8-14; col. 36, lines 51-58).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Ohtani, to include the geographical area, as taught by Sekizawa, so an operator can easily determine the area in which the machine requires a supply or maintenance and can efficiently deliver the supply (Sekizawa col. 8, lines 13-16).

Furthermore, Ohtani does not disclose the determining and the programming are performed prior to deployment of the hard copy output engine in an user environment. The particular way to determine and program does not patentably distinguish the claimed system because it imparts no structural or functional specificity. Furthermore, applicant has not persuasively demonstrated that the particular way to determine and program is critical or is anything more than one of the numerous ways that the skilled artisan would have found suitable for the purpose taught by Ohtani. Therefore, it would have been obvious to one or ordinary skill in the art at the time of the invention to provide any way to determine and program in the method taught by Ohtani because the

subjective interpretation of the particular way to determine and program does not

patentably distinguish the claimed invention.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Ohtani and Sekizawa as applied to claim 1 above, and further in view of U.S.

Patent No. 6,272,472 to Danneels et al. Ohtani and Sekizawa substantially disclose

the claimed invention, however, it does not disclose the reseller. The combination

discloses the manufacturer (see Sekizawa at least col. 19, lines 6-14). Danneels, on

the other hand, teaches the reseller (see at least abstract, summary). It would have

been obvious to one of ordinary skill in the art at the time of the invention was made to

modify the combination of Ohtani and Sekizawa, to include the reseller, to provide a

convenient way for a purchase to order the product (Danneels col. 3, lines 59-61).

Claims 2, 5, 9-10, 13, 16, 18 and 20 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Ohtani and Sekizawa as applied to claims 1, 8, and 15

above, and further in view of U.S. Patent No. 6,625,581 to Perkowski.

Regarding claims 2, 9-10, 13, 16, 18, and 20, Ohtani and Sekizawa substantially

discloses the claimed invention, however, it does not disclose the extracting of an

electronic address, which comprises the extracting a universal resource locator. The

combination discloses an ordering address to order the consumable goods (Ohtani col.

8, lines 28-32). Perkowski, on the other hand, teaches the extracting of an electronic

address which comprises the extracting of a universal resource locator (see at least col.

45, line 45 – col. 46, line 36). It would have been obvious to one of ordinary skill in the

art at the time of the invention was made to modify the combination of Ohtani and

Sekizawa, to include the universal resource locator, in order to find the web home page

of the vendor or supplier (Perkowski col. 46, lines 19-21).

Regarding claim 5, Ohtani and Sekizawa substantially discloses the claimed

invention, however, it does not disclose the determining of the electronic address of the

supplier is obsolete; determining a revised electronic address for the supplier; and re-

programming the memory with the revised electronic address to replace the obsolete

electronic address.   Perkowski, on the other hand, teaches the determining of the

electronic address of the supplier is obsolete; determining a revised electronic address

for the supplier; and re-programming the memory wit the revised electronic address to

replace the obsolete electronic address (see at least col. 46, lines 18-36). It would have

been obvious to one of ordinary skill in the art at the time of the invention was made to

modify the combination of Ohtani and Sekizawa, to include the determining of the

electronic address of the supplier is obsolete; determining a revised electronic address

for the supplier; and re-programming the memory wit the revised electronic address to

replace the obsolete electronic address, in order to determine and update whether a

particular supplier has a registered address on the Internet (Perkowski col. 46, lines 30-

36).

Regarding claims 13 and 18, Ohtani and Sekizawa substantially discloses the

claimed invention, however, it does not disclose the servlet. The combination disclose

the global Internet (see Sekizawa col. 43, lines 35-38). Perkowski, on the other hand,

teaches the servlet (see at least col. 14, lines 5-50; and Figures 2B1, 2B2 and 2B3). It

would have been obvious to one of ordinary skill in the art at the time of the invention

was made to modify the combination of Ohtani and Sekizawa, to include the servlet, in

order to provide a Web server environment and can fulfill multiple task (Perkowski col.

48, lines 38-44).

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Marissa Thein whose telephone number is 703-305-

5246. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jeffrey Smith can be reached on 703-308-3588. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

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Business Center (EBC) at 866-217-9197 (toll-free).

mtot
May 17, 2004

Jeffrey A. Smith
Primary Examiner